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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte REUVEN WACHTFOGEL,
DAVID RICHARDSON, SHLOMO KIPNIS,
JONATHAN MAISSEL, YOSSEF TSURIA,
and YONATAN SILVER

Appeal 2008-003134
Application 09/515,118
Technology Center 2600

Decided:¹ July 24, 2009

Before JOSEPH F. RUGGIERO, ROBERT E. NAPPI,
and THOMAS S. HAHN, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

This is a decision on appeal under 35 U.S.C. § 134(a) of the final rejection of claims 132, and 134 through 136. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm the Examiner's rejection of these claims.

INVENTION

The invention is directed towards a digital television recording apparatus and user interface. One aspect of the user interface allows the user to fast forward through commercials and allows the user to view shortened versions of commercials. See pages 4 and 32 of Appellants' Specification.

Claim 132 is representative of the invention and reproduced below:

132. A method for use with a broadcast system having a headend for broadcasting program material with commercials and a multiplicity of user locations, said method comprising:
receiving said program material being broadcast; and
dealing with said commercials,
wherein, for at least one of said commercials, said dealing with said commercials comprises dealing with said one commercial by presenting alternative shortened versions of other commercials in response to a user request to view said one commercial in a fast-forward or fast-backward mode.

REFERENCES

Alexander	US 6,177,931 B1	Jan. 23, 2001
Akiba	US 6,377,745 B2	Apr. 23, 2002

REJECTION AT ISSUE

Claims 132 and 134 through 136 are rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Alexander in view of Akiba. The Examiner's rejection is on pages 3 through 6 of the Answer.²

ISSUES

Claims 132, 135 and 136

Appellants argue, on pages 3 through 7 of the Brief and pages 2 through 7 of the Reply Brief³ that the rejection of claims 132, 135, and 136⁴ is in error. Appellants argue that the combination of Alexander and Akiba does not disclose presenting other commercials in response to a user request with respect to at least one commercial. Specifically, Appellants assert that the Examiner is improperly interpreting the claim (Br. 4, Reply Br. 3, 6-7). Further, Appellants argue that Akiba does not teach that the fast forward command presents shortened versions of other commercials as claimed. Br. 4-6, Reply Br. 3-6. Additionally, Appellants argue that there is no reason to combine the teachings of Alexander and Akiba.

² Throughout the opinion, we make reference to the Answer, mailed September 12, 2007 for the respective details thereof.

³ Throughout the opinion, we make reference to the Brief, filed March 9, 2007 and Reply Brief, filed November 5, 2007, for the respective details thereof.

⁴ Appellants' arguments group claims 132, 135, and 136 together, we select claim 132 as representative.

Thus, Appellants' contentions present us with three issues:

Have Appellants shown that the Examiner erred in interpreting the claim limitations directed to "other commercials" as being commercials other than "said one commercial in a fast-forward or fast backward mode"?

Have Appellants shown that the Examiner erred in finding that Akiba teaches presenting shortened versions of other commercials as recited in claim 132?

Have Appellants shown that the Examiner erred in concluding that one skilled in the art would combine the teachings of Akiba and Alexander?

Claim 134

Appellants argue that the Examiner's rejection of claim 134 is in error on pages 7 and 8 of the Brief. Appellants assert that since Akiba does not teach presenting other commercials as recited in claim 132, Akiba does not teach presentation of prepared meaningful commercials as recited in claim 134. Further, Appellants assert that Akiba teaches that the commercial is presented by reading out recoding data at the selected speed by suppressing frames, and that there is no teaching that this is a meaningful presentation as there is no consideration of whether an intended message will be conveyed.

Br. 7 and 8.

Thus, Appellants' contentions with respect to claim 134 present us with the additional issue of: have Appellants shown that the Examiner erred in finding that Akiba teaches that the shortened versions of other commercials are prepared in meaningful shortened versions of a full commercial?

PRINCIPLES OF LAW

In analyzing the scope of the claim, Office personnel must rely on Appellants' disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995). “[I]nterpreting what is *meant* by a word *in* a claim is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.” (emphasis in original) *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348 (Fed. Cir. 2002) (citations and quotations omitted).

On the issue of obviousness, the Supreme Court has stated that “the obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007). Further, the Court stated “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 416. “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of the invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *Id.* at 419-20.

The Examiner need not give patentable weight to non functional descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004) and our final decision in *Ex parte Curry*, 2005-0509 (BPAI 2005), (Affirmed, Rule 36, Fed. Cir., slip op. 06-1003, June 2006).

FINDINGS OF FACT

1. Appellants' Brief on page 3 cites to page 32 lines 20-25 of the originally filed Specification as providing support for the claim 132 recitation of presenting alternative shortened versions of other commercials in response to a user request to view at least one of the commercials in fast-forward mode.
2. Appellants' Specification states:

[d]uring fast-forward and fast-backward through the program, even when the program is a commercial, a specially prepared meaningful shortened version of a full commercial may be displayed on the television 50. Preferably, each shortened version of a full commercial may last about 3 seconds, and other shortened versions of other commercials may follow until browsing through fast-forward/fast-backward is ended. It is appreciated that the shortened versions of the full commercials are preferably characterized and treated as full commercials. Spec. 32, ll. 20-27.
3. Appellants' Specification states: "television programs include various types of television material such as programs, commercials, video clips, program guides, data, multimedia information, hypermedia links and teletex." Spec. 4, ll. 7-11.
4. Akiba teaches a recording and reproducing apparatus. The apparatus displays an index picture which includes an array of video data from plural channels. The array also includes time anterior and time posterior images of video data from each channel. A main display produces images from a channel selected in the index screen.
Abstract, see also Figures 5 and 7.

5. In forward reproduction of recorded media, images in the index pictures are scrolled upwards with the lapse of time. In reverse reproduction, the index pictures are scrolled down with the lapse of time. Akiba, col. 8, ll. 31-48.
6. The interval between images shown in the index pictures is adjusted based upon reproduction speed. Akiba, col. 8, ll. 49-55.
7. When the user selects an image in the index pictures, the frame displayed in the index is also displayed in the main picture display. Akiba, col. 9, ll. 40-54.
8. Akiba teaches that if a commercial is detected, and the reproduction speed is greater than 10 fold, a determination is made as to whether to display the commercial based upon the number of frames in the commercial. If the speed is less than or equal to 10 fold speed, the video is presented. Col. 12, l. 47 – col. 13, l. 21, see also flow chart of figure 10.
9. Akiba teaches that the process of forwarding through commercials is continued until the user issues a command to end the routine or after reproduction of the entire recoded video data. Col. 13, ll. 21-34.

ANALYSIS

Claims 132, 135 and 136

First issue.

We are not persuaded that the Examiner erred in interpreting the claim limitations directed to “other commercials” as being commercials other than “said one commercial in a fast-forward or fast-backward mode.” Claim 132 recites in the preamble “program material with commercials” and a method

step of “dealing with said commercials.” The step of dealing with commercials for “one of said commercials” comprises “presenting alterative shortened versions of other commercials in response to a user request to view said one commercial in a fast-forward or fast-backward mode.” The Examiner has interpreted “other commercials” as being broad enough to include commercials that follow a first commercial in a broadcast. Ans. 8. This interpretation of the claim is consistent with Appellants’ Specification on page 32. Fact 2. Further, we are not persuaded by Appellants’ argument on page 4 of the Brief that since:

[T]he claim term “other commercials” is preceded by “said” or by “the”, and necessarily refers to something not previously introduced in the claim. The claim term “other commercials” necessarily refers to something different than the at least one of the commercials that the user has requested to view in fast forward or fast backward mode.

Based upon this argument it is not clear if Appellants are: a) asserting that the “other commercials” is referring to commercials other than those in the program material, or b) asserting that the “other commercials” is referring to other commercials in the program material that are not the “at least one of said commercials.” Appellants’ Brief only identifies that the Specification has support for the second interpretation (interpretation b). Fact 2. We do not find the second interpretation is inconsistent with the Examiner’s interpretation of the claim term “other commercials.” Contrary to Appellants’ arguments on page 4 of the Brief and page 2 of the Reply Brief, the Examiner in interpreting the claim, has considered the “other commercials” as being separate from the “at least one of said commercials.” As discussed *infra*, the Examiner considers the “at least one of said commercials” to be the commercial which is being presented when the user

selects the fast-forward operation. Accordingly, we concur with the Examiner's interpretation of the claim term "other commercials."

Second issue.

Appellants' arguments have not persuaded us that the Examiner erred in finding that Akiba teaches presenting shortened versions of other commercials as recited in claim 132. As discussed above we concur with the Examiner's interpretation of the claim term "other commercials." Further, we note that the term "commercial," as discussed in Appellants' Specification page 4 (fact 3), is merely a description of the content of material being broadcast and, as such, is considered not functionally related to the broadcast. As such, we do not find that identifying the portions of the material to be a commercial to patentably distinguish the invention from the prior art. Thus, within the context of claim 132, any material for which the user selects the fast-forward option would meet the claimed "at least one of said commercials," and any other material would meet the claimed "other commercials."

The Examiner has found that Akiba's teaching of fast forward mode meets the claimed feature. Specifically, the Examiner has found that if the user selects the fast forward mode during one commercial, the system will present shortened versions of the commercial currently being viewed (i.e., "at least one of said commercials") and will also provide shortened versions of the commercials which follow (i.e., the "other commercials") as the fast forward command play of the recorded media continues until commanded to stop. Ans. 4, 8, and 9. We concur with the Examiner's findings regarding Akiba as we find ample evidence to support them. Facts 4-9. Further, we

are not persuaded of error in the Examiner’s rejection by Appellants’ arguments that Akiba fails to teach a series of commercials. Br. 4, Reply Br. 3. As discussed above, the term “commercial” is merely a description of the content of material being broadcast, thus, whatever content follows the content being displayed when the fast forward command is received meets the claimed “other commercials.”

Additionally, we are not persuaded of error in the Examiner’s rejection by Appellants’ argument on pages 4 through 6 of the Reply Brief that the fast forward command of Akiba is different from Appellants. Appellants argue that “Akiba discloses only a way of presenting a fast-forward version of whatever programming the viewer requests to view in fast-forward, and never substitutes a short version of a different commercial in place of the one(s) for which the user requests fast-forward.” Reply Br. 4. This argument is not commensurate in scope with the claim. As discussed above we do not find that the claim is limited to substituting one commercial for another.

For all of the aforementioned reasons, Appellants’ arguments have not persuaded us that the Examiner erred in finding that Akiba teaches presenting shortened versions of other commercials as recited in claim 132.

Third issue.

Appellants’ arguments have not persuaded us that the Examiner erred in concluding that one skilled in the art would combine the teachings of Akiba and Alexander. Appellants assert that there is no reason to combine Akiba and Alexander to arrive at the claimed invention as Akiba is concerned with eye strain in fast-forward/backward play and that Alexander

does not deal with commercials in fast-forward/backward play. Thus, Appellants conclude that there is no reason to combine the references to deal with commercials as claimed in claim 132.

As discussed above, we find ample evidence to support the Examiner's finding that Akiba teaches dealing with commercials in the manner claimed. Further, Examiner reasons that Alexander discloses a receiver system providing video programming with advertisements and that adding Akiba's teachings to Alexander's system provides the user with a means to control the reproduction speed (i.e., fast-forward) and view shortened versions of commercials. Ans. 5, 12. Thus, the Examiner has shown that the combination of the references is merely the combination of familiar elements which yield predictable results. Accordingly, we find no error in the Examiner's conclusion that one skilled in the art would combine the teachings of Akiba and Alexander.

As Appellants' arguments directed to the three issues related to the Examiner's rejection of claim 132, 135 and 136 have not persuaded us of error, we sustain the Examiner's rejection of these claims.

Claim 134.

Appellants' arguments have not persuaded us that the Examiner erred in finding that Akiba teaches that shortened versions of other commercials are prepared as meaningful shortened versions of a full commercial. As discussed *supra* the term "commercial" is merely a description of the content of material being broadcast and, as such, is considered not functionally related to the broadcast. Further, claim 134's description of the content of the commercial as "prepared meaningful shortened versions of a full

commercial” similarly is not functionally related to the broadcast. As such, similar to the term “commercial” we do not find that identifying portions of the material to be a “meaningful shortened version of a full commercial” patentably distinguishes the invention from the prior art. Additionally, even if the limitation were capable of differentiating the claim from the prior art, we are not persuaded by Appellants’ arguments. Appellants’ argument on pages 7 and 8 of the Brief, that Akiba’s “selection of screens based on a predetermined interval, without any preparation and without any consideration of whether an intended message will be conveyed” is not commensurate in scope with the claim. Appellants have not shown that the claim term “meaningful” necessarily imports such limitations into claim 134. Further, the process by which frames of the commercial to be displayed are selected is a preparation of the material.

As such, we are not persuaded that the Examiner erred in finding that Akiba teaches that the shortened versions of other commercials are prepared meaningful shortened versions of a full commercial. Accordingly, we sustain the Examiner’s rejection of claim 134.

SUMMARY

In summary, we sustain the Examiner’s rejections of claims 132 and 134 through 136 under 35 U.S.C. § 103(a).

ORDER

The decision of the Examiner to reject claims 132 and 134 through 136 is affirmed.

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Application 09/515,118

No period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

KIS

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